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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,882	01/07/2000	MARIKO EGAWA	TOS-125-USA-	2312

7590

07/24/2003

TOWNSEND & BANTA  
1225 EYE STREET NW  
SUITE 500  
WASHINGTON, DC 20005

EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/24/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/478,882

Applicant(s)

EGAWA ET AL.

Examiner

Shengjun Wang

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1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. The request filed on November 7, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/478,882 is acceptable and a CPA has been established. An action on the CPA follows.

2. Applicants' election in the parent application (paper No. 6) is presumed to carry over to the instant CPA since applicants have not indicated a contrary intention. Claims 1-10, 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

### ***Claim Objection***

3. Claim 25 is objected to because of the following informalities: Claim 25, line 2, the word "appying" appears to be a typographic error. Appropriate correction is required.

### ***Claim Rejections 35 U.S.C. § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 20 and 25 recite "a hydroxycarboxylic acid and/or its derivatives," the specification, or the claims, does not provide a clear definition of "derivatives." The claims are indefinite as to the "derivatives" encompassed thereby.

***Claim Rejections 35 U.S.C. § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 17 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Katsumata et al. (US Patent 5,601,806, of record).

9. Katsumata et al. teach a topical composition comprising thiotaurine compounds and the method of using the same for protecting skin. The concentration of thiotaurine in the composition is higher than 1 mmol/L. See, particularly, column 1, lines 13-20, column 3, lines 43-50, column 4, lines 60-63 and example 1 at column 12, and the claims. As to the particular properties herein recited, i.e., “environmental stress due to exposure of the skin to automobile exhaust gases,” note the claims are directed to a method of applying a composition comprising thiotaurine to the skin. Any properties exhibited by or benefits provided by the application of the composition to the skin are inherent and are not given patentable weight over the prior art method which comprises the same steps herein. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicants disclosed and/or claimed are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See, MPEP 2112.01. The burden is shifted to applicant to

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show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of composition containing the same components as instantly claimed. Applicant has not provided any evidence of record to show that the prior art composition do not exhibit the same properties as instantly claimed. Further, a person practice the method as claimed by Katsumata et al. would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

10. Claims 11, 17, 20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Tominaga (US patent 5,747,049, of record).

11. Tominaga teaches a cosmetic composition comprising thiotaurine compounds and method of using the same for treating or preventing cutaneous aging. See, particularly, the abstract, and the claims. A particular composition disclosed by Tominaga comprises 0.05% of thiotaurine (by weight), UV absorbent, and hydroxycarboxylic acid (citric acid). See formulation example 1, at columns 14-15.

12. As to the particular properties herein recited, i.e., "environmental stress due to exposure of the skin to automobile exhaust gases," note the claims are directed to a method of applying a composition comprising thiotaurine to the skin. Any properties exhibited by or benefits provided by the application of the composition to the skin are inherent and are not given patentable weight over the prior art method which comprises the same steps herein. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicants disclosed and/or claimed are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See, MPEP 2112.01. The burden is shifted to applicant to show that the prior art product does not inherently possess the same properties as

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instantly claimed product. The prior art teaches application to the skin of composition containing the same components as instantly claimed. Applicant has not provided any evidence of record to show that the prior art composition do not exhibit the same properties as instantly claimed.

Further, a person practice the method as claimed by Katsumata et al. or Tominaga would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

***Claim Rejections 35 U.S.C. § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumata et al. (US Patent 5,601,806, of record).

15. Katsumata et al. teach a topical composition comprising thiotaurine compounds and the method of using the same for protecting skin. The concentration of thiotaurine in the composition is higher than 1 mmol/L. See, particularly, column 1, lines 13-20, column 3, lines 43-50, column 4, lines 60-63 and example 1 at column 12, and the claims.

Katsumata et al. does not teach expressly the particular concentration herein.

16. However, the optimization of a result effective parameter, e.g., effective concentration of an active ingredient, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Further, a person practice the method as claimed by Katsumata et al. or

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Tominaga would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

17. Claims 11, 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tominaga (US patent 5,747,049, of record).

18. Tominaga teaches a cosmetic composition comprising thiotaurine compounds and method of using the same for treating or preventing cutaneous aging. See, particularly, the abstract, and the claims. The composition may further comprise UV absorbents, or UV blocking agents, wherein the UV absorbents or UV blocking agents may be selected from various organic or inorganic agents. See, particularly, column 2, lines 24-29, column 4, line 56 to column 5, line 40. The examples, column 5, lines 41-43, column 10, lines 51, and claims 4, 10, 11 and 17. The composition may be in various forms and may further comprising other active ingredients. See, particularly, columns 6-11. A particular composition disclosed by Tominaga comprises 0.05% of thiotaurine (by weight), UV absorbent, and hydroxycarboxylic acid (citric acid). See formulation example 1, at columns 14-15.

19. Tominaga does not teaches expressly the particularly concentration of thiotaurine herein, or the combination of thiotaurine with sun blocking agents.

20. However, the optimization of a result effective parameter, e.g., effective concentration of an active ingredient, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. The employment of hydroxycarboxylic acid, UV absorbents and UV blocking agents are obvious because they are all known to be useful in the thiotaurine containing cosmetic composition. Further, a person practice the method as claimed by Katsumata et al. or

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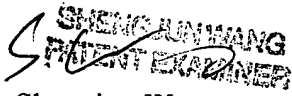
Tominaga would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

  
Shengjun Wang

July 15, 2003